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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,041	02/12/2002	Marc Husemann	tesa AG 1523-WCG	7504

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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,041

Applicant(s)

HUSEMANN ET AL.

Examiner

Olga Asinovsky

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 08/04/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The preliminary amendment on February 12, 2002 is noted.

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-6 and 13 in Paper No. on July 10, 2003 is acknowledged. The traversal is on the grounds that "any search of the adhesive itself is certain to include a search to the process for making it, and an adhesive tape using it and any search of the process and tape would also turn up the adhesive itself". This is not found persuasive because the claimed process for producing an adhesive requires a free-radical polymerization, whereas an adhesive in Group I can be made by solution polymerization in the presence of Ziegler-Natta catalyst. Also, a process for producing a PSA requires a post polymerization treatment by concentration, purification with an entrainer, distillation and again concentration by the melt processing. A process for post-polymerization treatment is related to class 528, subclass 499+. And, also, an adhesive in Group I can be used as a sealing material for electronic parts, whereas an article in Group III is an adhesive tape.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1711

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 11 of copending Application No. 10/077,658, as the preliminary amended. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 3, 11 of Application 10/077,658 discloses a PSA composition comprising (meth)acrylic (co)polymer, wherein said composition possesses an outgassing level of not more than 50 mg/g in total (in claim 1 in the preliminary amendment), and less than 10 mg/g in claim 11 as in the preliminary amendment. The difference between the present claims and the preliminary amended claims 1, 2 and 11 in the Application 10/077,658 is the requirement in the present claims that a PSA based on (meth)acrylic (co)polymer has at least two-phase domain structure. It would have been obvious to one of ordinary skill in the art to consider that a PSA composition in the claims 1, 2 and 11 in Application 10/077,658 has at least two-phase domain structure since the claims 1, 2 and 11 in Application 10/077,568 can include an additional vinyl compound containing functional groups. Because of this additional vinyl compound the second segment is formed, therefore a (meth)acrylic (co)polymer in the claims 1, 2 and 11 would have at least two-phase domain structure. The presence of a vinyl compound containing functional groups in the claims 1, 2 and 11 in Application

10/077,658 is the statement of the prima facie case of obviousness for obtaining at least two-phase of the domain structure in a PSA composition in the claims 1, 2 and 11 in Application 10/077,658.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11199832 or Pakusch et al U.S. Patent 6,552,116.

The present invention is a pressure-sensitive adhesive (PSA) composition based on (meth)acrylate (co)polymer and/or (meth)acrylic acid, wherein a said adhesive has at least two-phase domain structure and also an outgassing level of less than 10 mg/g, based on the weight of the composition, when measured by the tesa method.

(A) JP'832 discloses a PSA composition having low outgassing properties. A composition comprises: (a) a (meth)acrylic acid alkyl ester containing an alkyl group having 2-14 carbon atoms (a-1) and 30 –0 wt.% of a monoethylenic unsaturated monomer (a-2) copolymerizable with the ester (a-1), (b) 0.1-5 parts by weight of a radical chain terminator, (c) 0.02-5 parts by weight of a polyfunctional (meth)acrylate as

Art Unit: 1711

a crosslinking binder, (d) 0.005-1 part by weight of a photopolymerization initiator, and (e) 0.01-10 parts by weight of a silane coupling agent, abstract.

The difference is that JP'832 does not disclose at least two-phase domain structure for a pressure-sensitive adhesive composition. However, JP'832 discloses a monoethylenic unsaturated monomer (a-2) copolymerizable with the ester (a-1). A polymerizable monoethylenic unsaturated monomer (a-2) is readable for forming a second phase structure in applicants' claims. It would have been obvious to one of ordinary skill in the art to consider that a monoethylenic unsaturated monomer (a-2) is present in the amount of at least positive number for the purpose of forming a second phase structure because a monethylenic unsaturated monomer (a-2) can be selected from the amount of 0 – 30 wt.%, and, thereby obtain the claimed requirement.

(B) Pakusch discloses a multi-stage emulsion polymer containing at least one first domain having a Tg of from -10 to +40 C and at least one second domain having a Tg of from +50 to 120C with the proviso that the first and/or second domain contains from 0.1 to 10 wt. % of a nitrogen-containing adhesion monomer, column 2, lines 12-45 and column 4, lines 47-48. The first domain unit and the second domain init are based on (meth)acrylic (co)polymer, column 17, claim 1. This chemical formulation of the emulsion polymer having at least two-phase domain is readable in applicants' claims. The emulsion acrylic polymer will have an adhesive property in light of the presence of an adhesion monomer.

Pakusch does not disclose the outgassing characteristic. It would have been obvious to one of ordinary skill in the art to consider that the multi-stage emulsion polymer having the acrylic based (co)polymer would have applicants' claimed outgassing property since outgassing level is depending on the rate of the conversion of a monomer into a polymer, a residue of a non-polymerized monomer and a post-polymerization treatment for removing a solvent. Because the reference utilizes the materials readable in the present claims and any post-polymerization treatment process can be used in Pakusch's invention the outgassing property can be obtained.

6. Claims 1-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pakusch et al U.S. Patent 6,552,116 in view of Haak et al U.S. Patent 6,126,865.

Pakusch has been discussed above. Pakusch does not disclose outgassing property for a multi-stage emulsion polymer.

Haak discloses a pressure sensitive adhesive based on an acrylic acid ester. A PSA has been prepared without the use of large amount of solvent referring to "substantially solvent free" in the polymerization of the monomers, column 9, lines 3-9. The obtained PSA has outgassing property, column 12, line 12.

It would have been obvious to one of ordinary skill in the art to consider that a multi-stage emulsion polymer in Pakusch's invention has outgassing property since Pakusch does not use organic solvent as suggested by Haak. Because Haak discloses a process for polymerization of acrylic based monomers in the

Art Unit: 1711

absence of solvent or a minimum amount of solvent for producing an acrylic (co)polymer having outgassing property.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is relevant to show the state of the art knowledge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 703-308-0041. The examiner can normally be reached on 9:00 to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0041 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

O.A.

O.A.
August 4, 2003

Olga Asinovsky
Examiner
Art Unit 1711



James Seidleck
Supervisory Patent Examiner
Patent Center 1700